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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,175	03/30/2006	Gerd Loehden	284709US0PCT	4074

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

GILLESPIE, BENJAMIN

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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08/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/574,175	Applicant(s) LOEHDEN ET AL.	
	Examiner BENJAMIN J. GILLESPIE	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/11/2009; 5/12/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

Note

1. Since the grounds of rejection remains the same as set forth in the non-final rejection mailed 1/28/2009 - it is proper to make the current action FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hung et al ('656) in view of Calder et al (EP 0 247 426) and in further view of McGinniss et al ('563).
4. The rejection has been previously set forth in paragraphs 3-8 of the non-final rejection set forth 1/28/2009 and is herein incorporated by reference.

Response to Arguments

5. Applicant's arguments filed 4/28/2009 have been fully considered but they are not persuasive. Specifically, applicants argue the claimed invention is not rendered obvious by the

prior art because although Hung et al in view of Calder et al and McGinniss et al ('563) suggest polyurethane adhesives based on polyol having a polydispersity D of less than 1.9, wherein said polyol is produced by polymerizing ethylenically unsaturated monomers – the prior has failed to recognize applicants' alleged unexpected advantage gained when using said polyol - specifically that the resulting hot-melt adhesive exhibits superior “handling, storage stability, and open time” as exemplified in the declaration filed 4/28/2009.

6. In response, the data submitted in applicants' 37 CFR 1.132 Declaration filed 4/28/2009 has been noted, however, applicants are reminded that alleged superiority must pertain to the full extent of the subject matter being claimed. *In re Ackermann*, 170 USPQ 340; *In re Chupp* 2 USPQ2d 1437, 1440; *In re Murch*, 175 USPQ 89; *Ex Parte A*, 17 USPQ2d 1719. Accordingly, it has been held that to overcome a case of prima facie obviousness, a claim must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197 USPQ 227. Therefore, applicants' data fails to overcome the current prima facie case of obviousness since it does not represent the breadth of claim 1.

7. Specifically, applicants only provide three examples of representative polyol – and each polyol is based on the same three reactants:

- a) Methyl methacrylate
- b) N-butyl methacrylate, and
- c) Hydroxyl ethyl methacrylate

8. Therefore, while applicants have established enhance performance for polyol based on ethylenically unsaturated reactants: a), b), and c) - this fails to represent claim 1 which is open to any “ethylenically unsaturated monomers”.

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9. Furthermore, applicants' examples only disclose one amount of the polyol + polyisocyanate mixture – 12.2wt% of polyisocyanate and 87.8 wt% of polyol. However, claim 1 contains ranges of 10-80 wt% of polyisocyanate and 20-90 wt% of polyol. Applicants' data is also not representative because the polyol based on ethylenically unsaturated monomers only has polydispersities as high as 1.14, however, claim 1 allows for polydispersities as high as 1.9. Additionally, applicants' data is relevant for reactive hot-melt adhesives, however, claim 1 is not drawn to a reactive hot melt adhesive, but instead only "a mixture for *preparing* a reactive hot melt adhesive."

10. Finally, if applicants maintain that the experimental data is commensurate in scope with the breadth of claim 1 – it should be noted that one of ordinary skill in view of McGinnis et al would not find it unobvious to utilize polyol having polydispersity index D of less than 1.9. McGinnis et al teach that using polyol having a polydispersity index less than 1.9 results in polyol having superior molecular weight distribution, which directly impacts the strength of adhesives (Col 2 lines 30-56). Therefore, one of ordinary skill, in view of McGinnis et al, would be motivated to select polyol having a polydispersity less than 1.9 over a polyol with a polydispersity greater than 1.9 since it provides superior adhesion properties.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN J. GILLESPIE whose telephone number is (571)272-2472. The examiner can normally be reached on 8am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin J Gillespie/
Examiner, Art Unit 1796

/Vasu Jagannathan/
Supervisory Patent Examiner, Art Unit 1796